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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,326	07/31/2001	Robert W. Torres	41250/WPC/P526	3726

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EXAMINER

LUGO, CARLOS

ART UNIT PAPER NUMBER

3676

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/919,326

Applicant(s)

TORRES ET AL.

Examiner

Carlos Lugo

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5 and 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Office Action is in response to applicant's amendment filed on April 2, 2004.

#### *Election/Restrictions*

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 5 and 7-11, drawn to a device for sealing a cavity, classified in class 277, subclass 607.
- II. Claims 13-16, drawn to a high-pressure seal for an electrical connector, classified in class 277, subclass 919.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions in Group I and in Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the skirt of the sleeve does not require to be molded. The subcombination has separate utility such as used in a different pipe coupling than an electrical connector or to be for a low-pressure condition.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. Newly submitted claims 13-16 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The invention claimed in new claims 13-16 requires that the environment should be a high-pressure environment and skirt of the sleeve does not requires to be molded. The invention claimed in claims 5 and 7-11 does not requires the high-pressure environment and the device can be applied in a different connection than an electrical connection.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 13-16 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 5 and 7-11 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 3,792,416 to Moulin in view of US Pat No 4,627,647 to Hauff.

Regarding claims 5,8 and 9, Moulin discloses a device for sealing a cavity that comprises an interior surface. The device comprises a sleeve (150) having a skirt (formed when the sleeve is inserted inside the interior surface, Figure 2a).

The skirt includes a first section extending in a plane, which is substantially perpendicular to the longitudinal axis of the sleeve, and a second section comprising an interior and a sealing surface. A gap will be formed between the interior surface and the sleeve (Figure 2a). The sleeve and the skirt are made of an elastomeric material.

The skirt has a sealing surface having substantially the same shape as the interior surface of the cavity when the sleeve is inserted into the interior surface of the cavity. When it is inserted, the flange will deform only a small amount to form a seal between the sealing surface and the interior surface of the cavity.

The fact that the skirt is molded or not, applicant is reminded that the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

However, Moulin fails to disclose that the sleeve has the skirt before the insertion of the sleeve into the interior surface of the cavity (when the sleeve is subsequently inserted into the cavity). Moulin discloses that the sleeve will have a skirt having a sealing surface substantially the same shape as the interior surface of the cavity when the sleeve is inserted into the interior surface of the cavity. When it is inserted, the flange will deform only a small amount to form a seal between the sealing surface and the interior surface of the cavity.

Hauff teaches that is known in the art to have a sleeve (4) with a formed skirt (sealingly engaged to the interior of the cavity (5) before the insertion of the sleeve into the interior surface of the cavity.

It would have been obvious to one having ordinary skill in the art at the time the invention was made a skirt, as taught by Hauff, into a sealing device as described by Moulin, in order to make a better sealing between the inside surface of the cavity and the sealing surface and to prevent lost in the sealing contact because of excessive wrinkled.

As to claim 7, Moulin discloses that the sleeve includes a wiping land (174).

As to claim 10, Moulin discloses that the sleeve includes a wiping land (174).

As to claim 11, Moulin discloses that the wiping land cleans a portion of the interior surface of the cavity (Col. 9 Lines 13-16).

### ***Response to Arguments***

7. Applicant's arguments filed on April 2, 2004 have been fully considered but they are not persuasive.

Regarding applicant's arguments that Moulin fail to disclose that the shape of the skirt is presented before the insertion of the sleeve (Page 6 Line 16), Moulin, as modified by Hauff discloses that limitation.

As to applicant's arguments that it would not be obvious to use the teachings of Hauff into the device that Moulin presents (Page 8 Line 24), Hauff is used to teach that is well known in the art to have a skirt instead of having a flange that converts into a skirt.

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As to applicant's arguments that Hauff is not analogous art (Page 9 Line 11), Hauff is concern about connectors, same as the invention claimed in the instant application.

As to applicant's arguments that Moulin, alone or as modified by Hauff, fails to disclose the invention in claims 13-16 (Page 10 Line 1), the claims are withdrawn from consideration as been directed to a non elected invention (see restriction above).

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo whose telephone number is 703-305-9747. The examiner can normally be reached on 9-6pm EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

Carlos Lugo  
AU 3676

May 28, 2004.

A handwritten signature in cursive script that reads "Daniel P. Stodola". The signature is written in black ink and is positioned above the printed name and title.

DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600